



APPENDIX

IN THE SUPREME COURT OF THE UNITED STATES OCTOBER TERM No.——

No. 9875

LUCY B. O'LEARY and THE ROTOR CLOCK
COMPANY,

Petitioners,

v.

THE LIGGETT DRUG COMPANY,

Respondent.

No. 9876

LUCY B. O'LEARY and THE ROTOR CLOCK
COMPANY,

Petitioners,

v.

SEARS, ROEBUCK & COMPANY,

Respondent.

No. 9903

LUCY B. O'LEARY and THE ROTOR CLOCK
COMPANY,

Petitioners,

v.

THE JOHNSTON-SHELTON CO., a corporation
of Ohio, d. b. a. THE HOME STORE,

Respondents.

AFFIDAVIT

STATE OF OHIO, COUNTY OF MONTGOMERY, SS:

ALLAN O'LEARY being first duly sworn, deposes and
says as follows:

I am the son of William J. O'Leary, patentee of the
patent in suit in the above entitled causes; and I was in-
strumental in obtaining money for preparation, trial and
appeal of the above entitled causes, for my mother and a

corporation without other assets (The Rotor Clock Co.) both of Dayton, Ohio. I had no security except an interest in the proceeds in case of a successful prosecution. After the decision of the Court of Appeals in said causes, the friend who advanced the moneys required concluded that he could go no further therewith, and after consulting with my brother William J. F. O'Leary, it was decided by the two of us to go ahead with a petition for certiorari in the Supreme Court provided counsel would be willing to give us time to pay their fees. We have been able to provide the sum of \$400.00 for printing and Supreme Court fees and will have to save out of our incomes to pay any further amounts.

Up until this summer, I was employed as a teacher at Dayton University and my brother William was employed as a research worker at Niagara Falls, New York. I have responsibility for the livelihood of my mother and a second brother who is ill; and William J. F. O'Leary has responsibility for his own family (being married and I am not). This summer, hoping to increase my income, I have started out as an industrial consultant and commercial draftsman.

Neither my brother nor myself could by any possibility provide the necessary funds for filing a suit in another circuit to have our patent validity determined.

Prior to bringing the present suit, which was brought at Dayton, Ohio, in order to save money, I examined all non-self-starting electrical clocks on the market and also all non-self-starting phonograph motors on the market so far as I could, and believe that I fairly covered the field. All of them used O'Leary type motors. I selected the four largest makers of electric clocks of the non-self-starting type, and then in Dayton, Ohio, purchased from several stores, clocks made by the four largest makers. There are other makes of non-self-starting clocks but in my view they would not represent as much as ten percent of the market.

In the phonograph field the big majority of devices using non-self-starting electric motors, are made by Hammond at Chicago, who is the largest in this field (already acting as a defendant in this action), and Radio Corporation of America.

It would be entirely out of the question for my brother and me to finance a suit against The Radio Corporation particularly as we are advised by our counsel that we would have to provide experts of high standing in the electrical field and perform research experiments to develop our points in view of the record built up against us in the present suits.

I do not know whether or not the small makers of electric clocks are still in the market in their line, nor the extent to which war work has cut down their activities, nor do I know their plans for the future.

I am convinced that the only possible avenue whereby we can obtain a favorable conclusion as to our patent is by certiorari to the Supreme Court, and am confident that if the Supreme Court accepts our petition, my brother and I will be able to borrow money sufficient to pay the expense of printing and counsel for full presentation.

It is my opinion that except for the Radio Corporation, there is no substantial infringer from whom recovery could be had in sufficient amount to warrant the expense of a new suit even if we could obtain the moneys for preparing such a suit.

ALLAN O'LEARY.

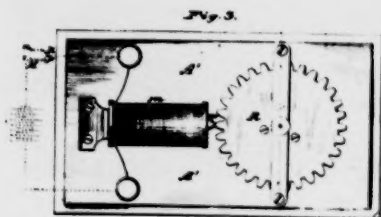
Sworn to before me and subscribed in my presence this 6th day of October, 1945.

EVA IRENE BEMBO,
Notary Public.

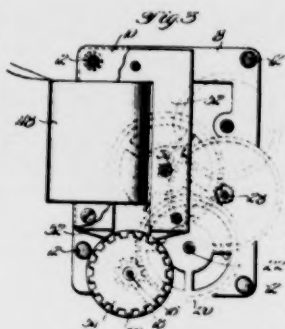
Notary Public in and for Montgomery County, Ohio.

My commission expires July 10, 1947.

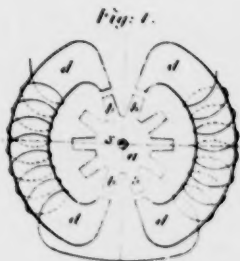




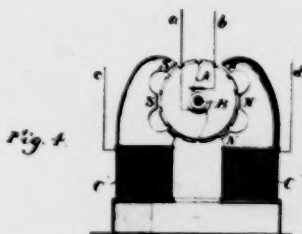
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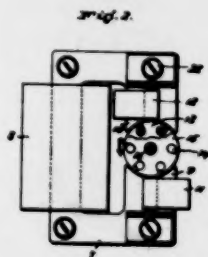
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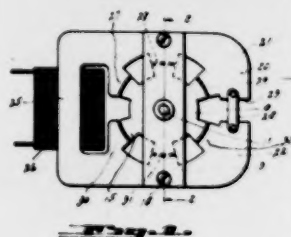
C. COERPER.



E. THOMSON.



P. C. HOLZE



W. J. O'LEARY



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IN THE
Supreme Court of the United States

OCTOBER TERM, 1945.

Case 546.

C. C. A. Appeal No. 9875.

LUCY B. O'LEARY AND THE ROTOR CLOCK
COMPANY,

Petitioners,

vs.

THE LIGGETT DRUG COMPANY,

Respondent.

Case 547.

C. C. A. Appeal No. 9876.

LUCY B. O'LEARY AND THE ROTOR CLOCK
COMPANY,

Petitioners,

vs.

SEARS, ROEBUCK & COMPANY,

Respondent.

**BRIEF OPPOSING PETITION FOR WRIT OF
CERTIORARI.**

*To the Honorable Chief Justice of the United States and
the Associate Justices of the Supreme Court of the
United States:*

*This brief is limited to Case 546, Appeal No. 9875, Lucy
B. O'Leary and The Rotor Clock Company, Petitioners v.
The Liggett Drug Company, Respondent, and to Case 547,*

Appeal No. 9876, *Lucy B. O'Leary and The Rotor Clock Company, Petitioners v. Sears, Roebuck & Company, Respondent*, these two appeals having been heard and argued together before the Circuit Court of Appeals for the Sixth Circuit.

Appeal No. 9903, *Lucy B. O'Leary and The Rotor Clock Company, Petitioners v. The Johnston-Shelton Co., a corporation of Ohio, d. b. a. The Home Store, Respondents*, was heard and argued separately, the argument having been presented by other counsel. The petition also includes this appeal, the case number in this Court being 548.

JUDGMENTS OR DECREES OF THE COURTS BELOW.

The decision of the District Court was reported in 53 Fed. Supp. 288.

In both Appeals Nos. 9875 and 9876 the decree was entered July 23, 1945. A single opinion was delivered by the Circuit Court of Appeals for the Sixth Circuit in these two cases and in Appeal No. 9903, this opinion having been reported in 150 Fed. (2d) 656. A copy of the decision of the Court of Appeals for the Sixth Circuit appears in Volume III of the Transcript of Record, starting page 2 thereof.

The Court of Appeals affirmed the decrees of the District Court.

RE PETITIONERS' STATEMENTS.

Respondents submit that petitioners' Statements starting on pages 2 and 11 of their Petition and accompanying Brief contain several unwarranted and incorrect allegations. They pertain to controverted evidence and controverted specific facts. It is Respondents' understanding that this Court does not grant certiorari to review evidence and discuss specific facts (*United States v. Johnson*, 268 U. S. 220, 227), and accordingly these unwarranted and incorrect allegations will not be discussed in detail in this brief.

ARGUMENT.

NO WARRANT FOR WRIT OF CERTIORARI.

First of all it is pointed out that the petition and the brief in support thereof do not present any reason falling within the suggestions in Rule 38 (5) of this Court.

As appears from page 2 of the petition, the District Court and the Court of Appeals made findings which are in agreement to the effect that the structure disclosed in the patent exhibited only mechanical skill over the art. It is believed to be the uniform practice of this Court to hold that the question of whether an improvement requires mere mechanical skill or the exercise of the faculty of invention is a question of fact. *Thomson Spot Welder Co. v. Ford Motor Co.*, 265 U. S. 445, 446; *Williams Mfg. Co. v. United Shoe Machinery Corp.*, 316 U. S. 364, 367.

Both the District Court and the Court of Appeals held the claims in suit to be invalid.

It appears to be the definite position of this Court that it must indeed be a strong case in which this Court will set aside the concurrent findings of the District Court and the Court of Appeals. *Goodyear Tire & Rubber Co., Inc. v. Ray-O-Vac Company*, 321 U. S. 275, 279; *Williams Manufacturing Co. v. United Shoe Machinery Corp.*, 316 U. S. 364, 367; *Sinclair & Carroll Company, Inc. v. Interchemical Corp.*, U. S., 65 U.S.P.Q. 297.

It is believed to be the practice of this Court not to bring up questions of fact as to which there were concurrent findings below, or to review questions of anticipation and invention as to which there is no conflict between decisions

of the Circuit Courts of Appeals. *General Pictures Co. v. Western Electric Co.*, 304 U. S. 175, 178. It is also believed to be the practice of this Court that this Court will accept the findings of the District Court concurred in by the Circuit Court of Appeals where no clear error was shown. *Anderson v. Abbott*, 321 U. S. 349. In this connection attention is invited to the words of the Circuit Court of Appeals, Record Volume III, page 18, reading:

“The findings of the district court with respect to Thomson Patent 545,554, and the statement that no more than mechanical skill of a person skilled in the art would be required for the conversion of the devices described in the Thomson and the Coerper patents into the O’Leary apparatus, particularly in view of the teaching in the British patent to Atkinson, are supported by substantial evidence and could not be appropriately termed clearly erroneous.”

PETITIONERS’ SPECIFICATION OF ERRORS.

Alleged error No. 1 reads:

“In failing to consider the historical impact of the invention on the existing art in appraising inventive novelty as against mechanical skill, when holding contrary to the decision of the appellate tribunal of the United States Patent Office on this point.”

The application resulting in the O’Leary patent in suit had rough sledding in the United States Patent Office, the Primary Examiner rejecting the important claims as not involving invention over the prior art. The Board of Appeals in the Patent Office reversed the decision of the Examiner (R. Vol. III, p. 2).

In the instant case, the District Judge had the benefit of the testimony of expert witnesses who testified concerning

prior patents including the United States patents to Holtz No. 1,892,553 and Rowe No. 1,919,395 and the British patents to Crompton No. 115,475 and Atkinson No. 7895, which were not before the Board of Appeals in the Patent Office. Moreover, the District Judge had the benefit of actual demonstrations of motors built according to the patent in suit, as well as the motors of the prior art. The Circuit Court of Appeals said in its decision (R. Vol. III, p. 14) with respect to the Holtz and Rowe patents:

"It is obvious from the discussion in the decision that the district court was much impressed with the demonstration at the trial of a motor precisely like the disclosure of the Holtz patent, which operated perfectly as a self-starting synchronous motor; and that a modified motor precisely like the disclosure of the Holtz patent, except that the shading coils were omitted from the field poles and the squirrel-cage winding was omitted from the motor, operated perfectly as a synchronous motor after it had been started in operation manually. The court stated that it had been demonstrated that the rotor of the modified motor had no residual magnetism, and that its operation was the same as the O'Leary motor, which also must be started manually. The assertion was made by the district court that there was substantial agreement that the Rowe patent is similar in construction and in mode of operation to the Holtz patent."

With respect to the Coerper patent, Petitioners erroneously allege (bottom of page 4 and top of page 5 of their petition) that said patent states in effect that it was not possible to do what O'Leary did. However, the Court of Appeals stated (R. Vol. III, p. 15):

"From the testimony of the expert Fox and his demonstration that the Coerper motor operated in the same manner with one field winding reversed, it would seem that no invention would inhere in the reversal by O'Leary of the connections to one of Coerper's field coils. And so, both from autoptic proference and

from the expert testimony, it cannot be said that the findings of the district judge as to the Coerper anticipation were clearly erroneous."

With respect to the decision of the Board of Appeals in the Patent Office, the Circuit Court of Appeals stated (R. Vol. III, p. 16):

"In rejecting O'Leary's claims, the primary examiner in the patent office stated that the modification of the motor in the Coerper patent involved only a problem of design and was not such a forward step in the art as to amount to invention. But the board of appeals in the patent office stated that no two adjacent poles of the same polarity on any particular phase of the current was found in Coerper as is true in O'Leary. There is some merit in the contention of the appellees that the Coerper motor was misunderstood by the patent board of appeals, as a result of erroneous representation; and that, therefore, less weight attaches to the finding of the board in that particular than would ordinarily be accorded. However, this controversy is considered of insufficient importance to require further comment."

In view of the fact that the District Judge had before him pertinent patents which were not before the Board of Appeals in the Patent Office, and had the further benefit of expert testimony and the opportunity to observe the demonstrations in open court which showed the substantial identity of the prior art with the patent in suit as regards both the structure and underlying principles, and further in view of the provision of Rule 52(a) of the Rules of Civil Procedure for the District Courts of the United States, reading:

"Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses,"

it is respectfully submitted that there is no substance at all to petitioners' allegation of error that the courts below failed "to consider the historical impact of the invention on the existing art."

Re alleged error No. 2, which reads:

"In holding that the express statements in the patents of the prior art with regard to the basic purposes of the described inventions, should be disregarded because they were incorrect or incomplete, when appraising what was *known* by the art and what was not; and in accepting as conclusive of what was and what was not known, the fact that the devices of the prior art could be stripped of parts and still operate."

In support of this allegation of error petitioners make the erroneous statement (pages 4 and 5 of their petition):

" * * * it was said in effect in the other of the two patents (Coerper) that because the rotating disk *retained* its magnetism, it was not possible to do what O'Leary did (See Appended Brief for References)."

There seems to be absolutely no basis for any such statement, and the District Court and the Court of Appeals made holdings contrary to this allegation by petitioners. The Coerper motor built according to the Coerper patent was operated in open court before the District Judge, and the Court of Appeals stated (R. Vol. III, pp. 15, 16):

"And so, both from autoptic proference and from the expert testimony, it cannot be said that the findings of the district judge as to the Coerper anticipation were clearly erroneous."

This Court discussed a somewhat similar situation in *Dow Co. v. Halliburton Co.*, 324 U. S. 320, Mr. Justice Murphy stating (page 328):

"The fact that prior to 1932 no one had apparently thought to use an inhibitor while acidizing an oil well to increase production cannot inject into the Grebe-Sanford process the attributes of an invention. Espe-

cially is this so since there is no evidence of any one trying unsuccessfully to inhibit hydrochloric acid for such purposes. He who is merely the first to utilize the existing fund of public knowledge for new and obvious purposes must be satisfied with whatever fame, personal satisfaction or commercial success he may be able to achieve. Patent monopolies, with all their significant economic and social consequences, are not reserved for those who contribute so insubstantially to that fund of public knowledge."

In other words, even if the patentee O'Leary had produced something different from the motors of the prior art, he merely utilized the existing fund of public knowledge for an obvious purpose, and did nothing to warrant any patent monopoly.

The patent in suit claims novelty for a plurality of polar salients which result in allowing more magnetic flux to pass, in turn resulting in more power, which really is a mere duplication, and this does not amount to invention. (*Dunbar v. Myers*, 94 U. S. 187, 195.) Moreover, the duplication disclosed in the O'Leary patent in suit is also shown in the prior art, as held by both the District Court and the Court of Appeals decisions.

Re alleged error No. 3, which reads:

"In relying on the testimony of experts as to what the art would know, and giving no regard to what the art had in fact done as the result of the patented invention."

It is believed that this alleged error has been sufficiently discussed in connection with alleged errors Nos. 1 and 2.

Re alleged error No. 4, which reads:

"In failing to hold that the patent in suit was valid on the authority of *Lawther v. Hamilton*, 124 U. S. 1 and *Dunn Mfg. Co. v. Standard Computing Scale Co.*, 163 F. 521."

Respondents see no point to this allegation of error. In the *Lawther v. Hamilton* case, decided by this Court in 1887, the question before the Court was whether or not a certain patent could be sustained as a patent for a process. In that case this Court reversed the Court below, holding that the patent did cover a process, and that the patentee had described it with sufficient definiteness so that the oil manufacturer would understand him. There seems to be no clear analogy to the instant case.

The *Dunn Mfg. Co. v. Standard Computing Scale Co.*, case was discussed by the Court of Appeals below (R. Vol. III, pp. 8, 9), the Court stating (R. Vol. III, p. 9):

“We doubt if the elimination of certain parts of prior machines and the simplification of their mechanism in the Dunn computing cheese cutter, held in that case to disclose invention as producing a better and more practicable and saleable machine, could now be held to constitute invention.”

The Court cited a number of decisions in the Sixth and other Circuits, and referred to an earlier case decided by this Court, *Dunbar v. Myers*, 94 U. S. 187, 199, which declared it to be settled law that the mere carrying forward of an original patented conception, involving only change of form, proportions, or degree, is not such invention as will sustain a patent. The Court of Appeals also referred (R. Vol. III, p. 10) for authority to decisions of this Court in *Atlantic Works v. Brady*, 107 U. S. 192, 200, and *Richards v. Chase Elevator Co.*, 159 U. S. 477, 486, 487.

It would appear, therefore, that none of the allegations of errors in the specification of errors (pages 10 and 11 of the petition) has any weight.

RE PETITIONERS' REASONS FOR GRANTING THE WRIT.

On page 9 of their petition, petitioners allege that certiorari should be granted because it is the only route within the means of the petitioners to obtain an adjudication favorable to their patent, for the reason that the principal infringers in the clock field were sued in the present litigations, and there are no funds available to bring any further suits. It is not believed that there is any force to this argument. According to the affidavit of Allan O'Leary, pages 19 to 21 of the Appendix accompanying the petition, there are other makes of non-self-starting clocks outside of those purchased for the purpose of these suits, and the phonograph field has not been touched at all.

Petitioners cite the decision of this Court in *Schriber Schroth Co. v. The Cleveland Trust Co.*, 305 U. S. 47. In that case certain patents had been held invalid by the District Court for want of invention, which decision was reversed as to certain of said patents by the Court of Appeals of the Sixth Circuit. This Court granted certiorari (304 U. S. 587) on a petition showing that notwithstanding the doubtful validity of the patents, litigation elsewhere with a resulting conflict of decision was improbable because of the concentration of the automobile industry in the Sixth Circuit. No analogous state of facts exists in the instant case, where non-self-starting clocks and non-self-starting phonograph motors are manufactured and sold in many places outside of the Sixth Circuit. And, the decisions of the District Court and the Court of Appeals in the instant case hold the claims of the O'Leary patent invalid and do not give a standing to said patent to provide a threat to industry.

As a second reason advanced by petitioners why Your Honors should grant certiorari, petitioners allege (page 9 of their petition) that "The matters involved here are of great public interest because this is a period where expansion of our economy is essential," and because the questions presented in the petition deal with a subject which has not been studied by this Court since *Lawther v. Hamilton*, 124 U. S. 1. Petitioners allege that the reasoning and application of the *Lawther v. Hamilton* case are in effect overruled by the Court of Appeals. As discussed above in connection with the *Lawther v. Hamilton* decision, the facts in that case were not at all analogous to the present case, and there is no suggestion in the decision of the Court of Appeals in the instant case that it was in any way overruling the *Lawther v. Hamilton* case.

CONCLUSION.

The petition and accompanying brief fail utterly to present any sound reason for granting the writ of certiorari. The concurring decisions of the District Court and the Court of Appeals were based upon findings of fact (relating both to patents not considered by the Patent Office and to demonstrations and expert testimony not available to the Patent Office) clearly showing lack of invention. It is submitted that the petition for certiorari should be denied.

Respectfully submitted,

HENRY M. HUXLEY,
Attorney for Respondents.

RALPH MUNDEN,
Of Counsel.

November 14, 1945.

